

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 8, 2006. Applicants appreciate the Examiner's consideration of the Application. At the time of the Office Action of May 8, 2006, Claims 1-44 were pending in the Application and stand rejected. Claims 1, 3, 6-16, 18-22, 24-28, 30, and 33-44 have been amended to clarify, more particularly point out, and more distinctly claim inventive concepts previously present in these claims. In order to advance prosecution of this Application, Applicants have responded to each notation by the Examiner. Applicants respectfully request reconsideration and favorable action in this case.

Objections

The Examiner indicates that Claims 1-44 are objected to based on informalities. Claims 1, 3, 6-16, 18-22, 24-28, 30, and 33-44 have been amended in accordance with the Examiner's requirement to correct the informalities. Accordingly, Applicants respectfully request that the Examiner remove the objections to Claims 1-44.

Section 103 Rejections

1. Claims 1-4, 6-9, 11-14, and 16-44 are patentable over the *Toth-Maes* combination

The Examiner rejects Claims 1-4, 6-9, 11-14, and 16-44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2005/0053068 A1 of Toth et al. ("*Toth*") in view of U.S. Patent Application Publication No. 2004/0266388 A1 of Maes ("*Maes*"). Applicants respectfully traverse this rejection for the reasons discussed below.

Applicants respectfully submit that the combination of *Toth* and *Maes* as proposed by the Examiner fails to disclose, teach, or suggest elements specifically recited in Applicants' claims. For example, the *Toth-Maes* combination proposed by the Examiner fails to disclose, teach, or suggest "directing an enabler mobile to facilitate delivery of the multicast content to the user device using the bearer path, the *enabler mobile located in the cell, the enabler mobile distinct from a base station*," as recited in Applicants' independent Claim 1, as amended (emphasis added).

The Examiner relies on a radio access node (RAN) of *Toth* to teach an enabler mobile located in the cell. See Office Action, page 4, paragraph 6. The Examiner relies on service

enablers of *Maes* to teach an enabler mobile distinct from a base station. *Id.* at page 4, paragraph 7 - page 5, paragraph 1. The RAN of *Toth* and the service enablers of *Maes*, however, cannot be properly combined because of the following reasons.

A. The proposed combination would change the principle of operation.

The RAN of *Toth* and the service enablers of *Maes* cannot be properly combined because the proposed combination of the *Toth* RAN and the *Maes* enabler devices would change the principle of operation of the *Maes* service enablers and the *Toth* RAN. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

First, the proposed combination would change the principle of operation of the *Maes* service enablers. The *Maes* service enablers provide services within a gateway located between access providers and content providers. According to *Maes*, “[Virtual mobile service provider] VMSP 100 may thus act as a gateway between access providers 102, 104, 106 and content providers 108, 110, 112 that securely integrates, delivers and manages in-house and third party applications and content.” *Maes*, paragraph 0027. *Maes* also discloses, “VMSP 300 includes a plurality of mobile service enablers 302, 304 that may be used to provide a mobile service.” *Maes*, paragraph 0028. That is, the *Maes* service enablers ***provide services within a gateway between access providers and content providers***. Combining the *Maes* service enablers with the *Toth* RAN to yield ***an enabler mobile located in a cell*** would change the principle of operation of the *Maes* service enablers. Thus, the *Maes* service enablers and the *Toth* RAN cannot be properly combined.

Second, the proposed combination would change the principle of operation of the *Toth* RAN. The *Toth* RAN ***operates as a base station***. According to *Toth*, “In the given example a number of mobile stations M1-M10 are wirelessly connected to a number of base stations, also denoted radio access nodes (RAN1-RAN5).” *Toth*, paragraph 0050. Combining the *Toth* RAN with the *Maes* service enablers to yield ***an enabler mobile distinct from a base station*** would change the principle of operation of the *Toth* RAN. Thus, the *Maes* service enablers and the *Toth* RAN cannot be properly combined.

B. The proposed combination has no reasonable expectation of success.

The RAN of *Toth* and the service enablers of *Maes* cannot be properly combined because there is no reasonable expectation of success. The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. MPEP §2143.02 (citing *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)).

As discussed above, the *Maes* service enablers *provide services within a gateway between access providers and content providers*, and the *Toth* RAN *operates as a base station*. There is no reasonable expectation of success that the *Maes* service enablers and the *Toth* RAN can be combined to yield an enabler mobile *located in a cell and distinct from a base station*. Thus, the *Maes* service enablers and the *Toth* RAN cannot be properly combined.

Consequently, at a minimum, the proposed *Toth-Maes* combination fails to disclose, teach, or suggest “directing an enabler mobile to facilitate delivery of the multicast content to the user device using the bearer path, the enabler mobile located in the cell, the enabler mobile distinct from a base station,” as recited in Applicants’ independent Claim 1.

For at least the foregoing reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims. For at least similar reasons, Applicants also respectfully request reconsideration and allowance of independent Claims 6, 11, 16, 18, 20, 22, 24, 26, 28, 33, 38, 43, and 44 and their dependent claims.

2. Claims 5, 10, and 15 are patentable over *Toth-Maes-Rodriguez* combination

The Examiner rejects Claims 5, 10, and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Toth* and *Maes* in view of the Patent Cooperation Treaty (PCT) application WO 03/039024 A2 of Rodriguez Gil, R et al. (“*Rodriguez*”). Applicants respectfully traverse this rejection for the reasons discussed below.

For reasons similar to those discussed above, Claims 5, 10, and 15 are patentable over the *Toth-Maes-Rodriguez* combination proposed by the Examiner. Accordingly, Applicants respectfully request reconsideration and allowance of dependent Claims 5, 10, and 15.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Keiko Ichiye, the Attorney for Applicants, at the Examiner's convenience at (214) 953-6494.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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